

Attorney Docket No.: WSTR-0014C
Inventors: Shiekhattar, Ramin
Serial No.: 10/634,574
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REMARKS

Claim 13 is pending in this application. Claim 13 has been rejected. Claim 13 has been amended. No new matter has been added by these amendments to the claims. Applicant is respectfully requesting reconsideration in light of these amendments to the claims and the following remarks.

I. Withdrawn Claim Rejections

Applicant acknowledges the withdrawal of the rejection of claims 4-6 under 35 U.S.C. 112, first paragraph and the rejections under 35 U.S.C. 102(a) and 102(b) of claims 5 and 6, respectively.

II. Objection to the Claims

Claim 13 has been objected to for reciting "RBCC36" instead of "BRCC36" in line 5 of claim 13. Appropriate correction has been made to claim 13. It is therefore respectfully requested that this objection be withdrawn.

III. Rejection of Claims Under 35 U.S.C. 112

Claim 13 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is suggested that claim 13 refers to BRCC36 and BRE protein, described in the specification at page 5 as SEQ ID NO:10 and SEQ ID NO:9, respectively. The Examiner suggests that Ching et al. ((2001) *Biochem. Biophys. Res. Commun.* 288:535-545) teach that BRE is a protein of multiple isoforms. It is further suggested that page 15 of the specification refers to

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BRCC36 as SEQ ID NO:9 and BRCC45/BRE as SEQ ID NO:8. It is concluded that it is not clear if the terms in the claims "BRCC36" or "BRE" are narrow in scope, *i.e.*, limited to single species, or if the terms are broader in scope, including isoforms or homologous proteins from other species. Applicant respectfully disagrees with this rejection.

As a preliminary point, lines 27-28 of page 5 and lines 13-14 of page 17 of the specification indicate that SEQ ID NO:9 and SEQ ID NO:10 respectively refer to BRE and BRCC36. Accordingly, the specification at page 15 has been amended to correct the inadvertent typographical error which indicates that BRE and BRCC36 are set forth respectively in SEQ ID NO:8 and SEQ ID NO:9. Support for this amendment is found at page 5 (lines 27-28) and page 17 (lines 13-14).

Moreover, in an earnest effort to clarify the nature of the claimed proteins, Applicant has amended claim 13 to indicate that BRCC36 refers to the BRCA1-BRCA2-containing complex 36 protein (see page 4, lines 14), the characteristics of which are clearly set forth in the paragraph bridging pages 5 and 6. In light of this clarification of the claimed method, it is respectfully requested that this rejection be reconsidered and withdrawn.

IV. Rejection of Claims Under 35 U.S.C. 102

Claim 13 has been rejected under 35 U.S.C. 102(e) as being anticipated by Chiu (U.S. Patent Application No. 2007/0010434; effective filing date 9/16/02). The Examiner suggests that Chiu teaches SEQ ID NO:262, a sequence which is the same as the BRE of the instant invention. It is suggested that Chiu suggests the use of SEQ ID NO:262 in a method comprising contacting a cell

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expressing said protein with a test agent that may be an antisense molecule and monitoring the ability of the test agent to alter the expression of the protein. It is suggested that because provisional applications 60/401,433 and 60/449,950, from which the instant application claims priority, do not disclose a method comprising contacting a cell expressing BRE protein with a test compound, the effective filing date of the claim of the instant application is 8/5/03.

Applicant respectfully disagrees with this rejection. However, in the interest of facilitating the prosecution of this application, Applicant has removed reference to BRE from claim 13. In so far as the cited reference does not teach or suggest the identification of agents that inhibits the expression of BRCC36, this reference cannot be held to anticipate the claims as currently presented. It is therefore respectfully requested that this rejection be reconsidered and withdrawn.

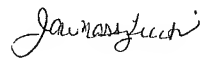
V. Conclusion

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record. Accordingly,

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favorable reconsideration and subsequent allowance of the pending claim is earnestly solicited.

Respectfully submitted,



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